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EXAMINER

SPERTY, ARDEN II

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,244

Applicant(s)

BETHUNE ET AL.

Examiner

Arden B. Sperty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.135(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 16-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

FINAL ACTION

Specification

1. The disclosure is objected to because it does not appear to be consistent with the claims and the structure argued by Counsel.
2. The disclosure is further objected to because it lacks section headings, such as Background of the Invention, Brief Description of Drawings, etc.

Drawings

3. New corrected drawings are required in this application because numeral 6 of Figures 2B and 2C indicates a raised portion, while the specification dictates that the decorative pattern 6 is the removed or indented portion; Figures 6A and 6B are informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-15 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As stated in the previous office action, the term "partially delimiting" is unclear. As is indicated below, "discontinuous" is a more descriptive term and the claims would be much clearer if the term "discontinuous" was used.

The claims are further indefinite because they are not consistent with the specification and Counsel's arguments. The claims are drawn to two distinct coating systems, while Counsel describes a different interpretation than is gleaned from the claims as drafted.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 8-12 and 14-15 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,505,320 to Burns et al, as stated in the previous office action.

Regarding claims 1 and 25, the Burns reference discloses a support having a first metallic coating of $n=2$ layers, designated 2 and 3, and a second metallic coating of $n=1$ layer, designated 4, wherein the outer metallic layer (3) of the first metallic coating is Cu and has a color and appearance differing from that of the outer metallic layer of the second metallic coating of Cr (col 3, line 22- col 4, line 18). As shown in Figure 5, the first metallic coating delimits a decorative pattern and the second metallic coating corresponds to the decorative pattern.

Regarding claim 2, USPN 4,971,188 to Deters is cited to show that plastics similar to those disclosed by Burns may be metallicity coated by a galvanoplasty process (col 2, lines 8-10 and 45-48). Therefore the limitations of the claim are met.

Regarding claim 3, the Burns reference discloses the object according to claim 1 wherein the support is a polyester (col 2, line 64).

Regarding claims 8-12 and 14-15, the shape of an object is a matter of personal preference predicated on ultimate intended use. Absent an indication of unexpected results with respect to the shape of the object, no patentable distinction is seen.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3704403, DE 3030403 and USPN 6546751.

Each of the cited references teach molded substrates having decorative patterns formed thereon, the decorative patterns defined by at least two metals of contrasting colors. Although the references may not specifically teach the number of claimed layers, no patentable distinction is seen absent a showing of significance with respect to the additional layers of the first metallic coating. The shape of the article to which the decorative metals are applied is merely a matter of personal preference and would have been obvious to one of ordinary skill in the art. Therefore, the limitations of the claims are met.

Response to Arguments

10. Applicant's arguments filed March 23, 2004 have been fully considered but are not found persuasive, as explained below.

11. In an effort to expedite prosecution and further clarify resounding issues, the examiner herein makes every attempt to address each of Counsel's arguments individually and completely.

12. Beginning on page 7 of the remarks submitted March 23, 2004, Counsel first states:

Applicants note that the Examiner appears to have misconstrued at least one recitation in claim 1.

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The apparent confusion is a result of the specification failing to draw a nexus between the layers (6, 10, 11, 12) of figures 2A-2C and 6B and the first and second metallic coatings, as will be thoroughly explained in the following paragraphs. It appears that the specification fails to clarify the orientation of the coatings and the layers of each coating; it is not clear which of the first and second metallic coatings is closer to the support and which one is further away from the support. Hence the need for the Interview of July 30, 2003.

13. In the same paragraph, Counsel further questions the examiner's concern regarding the language "partially delimiting." At the current impasse, Counsel argues that the language is clear, while the examiner maintains that it is not clear, evidenced by counsel's statement in the following paragraph that, "Contrary to the Examiner's apparent assertion, neither the claims nor the specification creates any ambiguity concerning the scope of the claims." While the claims may make sense to the individual drafting them, they must also make sense to one of ordinary skill in the art. The examiner maintains that, as drafted, the claims and specification create significant ambiguity concerning the scope of the claims. However, the examiner respectfully recognizes that the term "discontinuous," introduced in new claim 25, sheds much clarity on the crux of the invention. Counsel's statement, "when the first metallic coating partially delimits the decorative pattern, one or more other portions of the object may cooperate with the first metallic coating to delimit the decorative pattern," is an example of how the concept of one discontinuous layer allowing an underneath layer to show through is made confusing. Counsel's argument would not be persuasive, or even intelligible, without the introduction of "discontinuous" in claim 25. In other words, it is now the examiner's understanding that a **discontinuous layer allows an underneath layer to show through.**

14. On page 8 Counsel draws the examiner's attention to paragraph 13 as evidence that the first metallic coating may be formed of two or more metallic layers and that the second metallic coating

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may be formed of at least one less layer than the first metallic coating. Unfortunately, no nexus is drawn to the **orientation** of the first and second metallic coatings. So, while it is understood from this statement that the second coating has one less layer than the first coating, it is still not clear which coating is closer to or further away from the support; it is unclear whether the numbering of the coatings is from the surface of the support outward or from the outward surface of the final product in toward the support.

15. The statement from the Office Action, "other layers may be found between any of the claimed layers," (Office Action, page 3, lines 9-10) was merely included to clarify the examiner's interpretation of the repeated use of the relative term "outer" in the claims. The statement was meant to show that "outer" was understood as respective to the metal layers alone, not respective to the final product whose truly outer or outermost layer could be a clear coat or the like. Repeated use of "outer" to refer to numerous different surfaces deemed clarification necessary.

16. On page 9 Counsel addresses the interview at the USPTO on July 30, 2003. In light of Counsel's inability to recall making the statement that layers 10 and 11 correspond to the second metallic coating, it should be noted that Counsel **suggested** the wording of the Interview Summary, as was witnessed by the examiner and the supervising Primary Examiner Archene Turner. A copy of the Interview Summary was given to Counsel at the conclusion of the interview, at which time Counsel had ample opportunity to voice concerns regarding the details of the interview. An Interview Summary is not a word-for-word transcript of a meeting. If Counsel required more detail recorded in the summary, then he should not have suggested the language that is currently recorded. Counsel's indication that layers 10, 11, and 12 comprised the first metallic coating and 10 and 11 also comprised the second metallic coating was the basis for the suggestion that the claims be redrafted and accompanied by an RCE, since the implied, but unintelligible structure that would need to be conveyed in new claims was different from that of the previously examined claims.

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17. According to paragraph 27 of the specification, the eliminated portion corresponds to a decorative pattern. Therefore, although the line coming from numeral 6 in Figure 2B erroneously points to the raised portion where it should point to the eliminated portion, according to Counsel's explanation, the second metallic layer corresponds to layers 10 and 11 where there is no layer 12 covering layer 11, i.e. in the area which should be designated as 6. Counsel also indicated in the interview that layers 10, 11, and 12, where layer 12 is not removed to form pattern 6, make up the first metallic film. As was explained to Counsel in the interview (and forming the basis for the requirement that an RCE be submitted with newly drafted claims), when the claims are drawn to **two distinct coating systems**, any one particular layer (10, 11, or 12) may not be included in **both** coating systems at the same time. Layers 10, 11, or 12 are **either** in the first metallic coating or in the second metallic coating, but not in both. The problem lies in that the claims require two separate coatings, one having $n \geq 2$ layers and the other having $n - 1$ layers, but what Counsel explained was one coating system where one or more layers were removed to show a contrasting metal color.

18. In the paragraph bridging pages 9 and 10 of Counsel's remarks, it is again stated that paragraph 13 of the specification recites the first and second metallic coatings. This is not disputed. It is also again stated that figures 2B and 2C illustrate the coatings described in paragraph 13 of the specification. The examiner disagrees for the reasons stated previously, which are restated: the specification fails to draw a nexus between the layers (6, 10, 11, 12) of figures 2A-2C and 6B and the first and second metallic coatings. Applicant is requested to point out **specifically** which layers (10, 11, 12) comprise a first metallic coating, which layers (10, 11, 12) comprise a second metallic coating so that the relationship of the coatings and layers is clear, keeping in mind that no layer (10, 11, or 12) may be included in **both** coating systems at the same time, because as currently drafted the claims recite **two distinct coating systems**. Layers 10, 11, or 12 are **either** in the first metallic

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coating or in the second metallic coating, but not in both, as was stated in the Interview July 30, 2003.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. This application contains claims 16-24 drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Arden B. Sperty
Examiner
Art Unit 1771

20 May 2004


Ms. Arti R. Singh
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